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To: US PTO, Before Final

TC 2818

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## REMARKS:

☐ Urgent☐ For your review☒ Reply ASAP☐ Please commentApplication Number: 10/691,400Filing date: October 22, 2003First named inventor: Hao Cui, et al.Attorney docket number: 03-0979

Transmitted herewith for filing via facsimile:

- Amendment in response to the Office Action dated December 20, 2004.

Pursuant to 37 C.F.R. 1.8, I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date indicated below:

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Connie del Castillo

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Hao Cui et al.

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) Group Art Unit: 2818

)

Serial No.: 10/691,400

) Examiner: Mai Huong C. Tran

)

Filed: October 22, 2003

) Atty. Docket No.: 03-0979

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For: Ultra Low Dielectric Constant Thin  
Film

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**RECEIVED  
CENTRAL FAX CENTER****JAN 19 2005****RESPONSE TO OFFICIAL ACTION**  
**Restriction/Election Requirement**Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This response is presented to the Office Action mailed December 20, 2004, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group II, method claims 6-17.

**Remarks/Arguments**

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

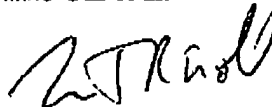
In searching the Group II claims, the class and subclass for the Group I claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the Office Action is provided herein, and request that the application proceed to examination.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to deposit account 12-2252.

Respectfully Submitted,  
Hao Cui et al.



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Date: January 14, 2005